

NEUBURGER -- 10/673,579  
Client/Matter: 081069-0305991

IN THE DRAWINGS:

The attached sheets of drawings includes changes to Figures 6 and 16. These sheets replace the original sheets showing Figures 6 and 16.

REMARKS

Reconsideration and allowance of the present application based on the foregoing amendments and the following remarks are respectfully requested.

Claims 1-31 and 53-60 are currently pending in the present application. Of these, claims 53-60 are newly added.

Restriction Requirement

The Applicants acknowledge the restriction requirement set forth by the Examiner, and confirm that claims 1-16 have been elected for prosecution with traverse. The grounds for traversal are that independent claim 17 includes the limitations of claim 1, and thus it is proper for them to be examined together. This likewise applies to claims 18-30, which depend from claim 17.

Drawing Objections

The Examiner's drawing objections are noted.

The Examiner correctly notes that the selected substrate is not included in some of the Figures. This is because once the reader of the specification understands that the selected substrate is a substrate to which adhesive is to be applied, such as a label, photograph, etc., there is no real need to repeatedly include the selected substrate in each and every Figure. One of ordinary skill in the art can easily understand how the various devices and processes work by reading the specification and drawings as a whole.

With respect to Figure 6, the Applicants enclose a new Figure 6 with the reference numeral 30 included.

With respect to the Examiner's comments concerning the core, a core is a well-known structure in the context of wound materials. Indeed, anyone of ordinary skill in the art would recognize that the core (*see, e.g.*, core 206 in Figure 16) is the structure on which the materials are wound. This is reflected plainly in the claim language (*see, e.g.*, claim 1, line 10 – "wound about said core"). Indeed, a look around any home shows very simple examples of cores on which substrates are wound: paper towel rolls and toilet paper rolls have cardboard cores on which their substrates are wound. Thus, in preparing the

specification, the Applicants did not endeavor to provide an overly detailed description of the well-known construction of the core, as any person skilled in the art would immediately understand what the Applicant is referring to. As such, the Applicants submit that the specification is clear as to its description in this respect.

The Applicants note the issues raised by the Examiner with respect to Figure 16 and the accompanying description. A new Figure 16 is enclosed, and the corresponding language in the specification has been amended above to correct these errors.

With respect to the term “radially” as opposed to “circumferential,” the Applicants respectfully submit that they have used the term “radially” completely accurately, and that using the term “circumferential” to describe the direction in which certain items face would be geometrically incorrect. For example, in paragraph [0070], the specification correctly points out that the release surface faces generally radially outwardly, and the permanent adhesive faces generally radially inwardly. This is entirely correct, because those items face in a radial direction. A circumferentially facing surface would face be perpendicular to a radial direction, and would face in the direction of a tangential line. As such, the Applicants submit that they have used the term “radially” appropriately in line with its correct geometric meaning.

Accordingly, the Applicant respectfully requests that these objections be withdrawn.

#### Section 112, ¶2 Rejections

With respect to the term “core,” the Applicant refers the Examiner to the discussion above on this same issue. The term “core” is a well-known and understood term in the art, and it is used in the specification consistent with its usage as a part around which a substrate is wound. There is no reason to further define or limit what the core is, as it is a self-explanatory term.

The same comments are submitted to apply to the Applicants’ use of the term “frame” in claim 2. This is a well-established and unambiguous term that needs no clarification.

The Applicants also refer the Examiner to the discussion above with regards to his concern about the use of the term “radial.” The Applicants submit that the term radial is used in accordance with its proper geometrical meaning.

As to the Examiner's suggestion concerning the term "release surface," the Applicants have amended claim 1 in a self-explanatory way to satisfy the Examiner's rejection.

As to the Examiner assertion that "selected substrate" is an indefinite term, the Applicants submit that this term is entirely definite. Paragraph [0041] specifically points out that the "selected substrate" may be of any of a variety of materials. Indeed, that is the purpose of the invention – to enable the user to make a repositionable substrate from a substrate that he or she has "selected." Thus, the term is clear in the context of the art and the specification, as it is clearly intended to refer to a substrate that is selected by the user. If the Examiner has a suggestion for language that would alleviate his concerns, he is invited to suggest it to the undersigned.

With respect to the issue raised by the Examiner with the term "adjacent to" concerning the adhesives, the Applicants submit that the original language is clear, but have made self-explanatory amendments to alleviate the Examiner's concerns.

The Applicants have also amended the language concerning the opposite nature of the base substrate surfaces to satisfy the Examiner's objection.

For the foregoing reasons, it is therefore respectfully requested that the Examiner withdraw the outstanding rejections under § 112, ¶ 2.

Similar amendments have also been made to claim 17, in anticipation of it remaining in the present application.

#### Obviousness Rejection

Claim 1 stands rejected over the allegedly admitted prior art in view of Sasaki. The Applicant respectfully requests the Examiner to reconsider this rejection.

To sustain an obviousness rejection, the Examiner must cite objective evidence of a motivation for one of ordinary skill in the art to combine the applied references to arrive at the claimed invention. *See, e.g.*, MPEP § 2143.03. However, the fact that references are capable of being combined or modified as asserted by itself is not sufficient to such a motivation. *See, In re Mills*, 916 F.2d 680, 382, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990).

There, the Examiner has cited the individual elements of claim 1 in the prior art, but has not cited to any evidence in the record suggesting that the references should be combined

as asserted by the Examiner. Instead, the Examiner concludes that, because Sasahi teaches a pre-made label comprising a label backing, a layer of permanent adhesive on the backing, and a layer of repositionable adhesive on the permanent layer, that it would be obvious to provide the adhesive layers in reverse order for enabling the user to apply those layers to other substrates. However, none of the references of record suggests such an approach.

As noted in the Background section of the present application, there are a number of other ways to apply adhesive to a selected substrate. In view of these other available approaches, the Examiner cannot merely conclude that one of ordinary skill in the art would necessarily be motivated to invent the approach of claim 1.

Moreover, the admitted art relied upon by the Examiner relates to a tape dispenser. Tape dispensers do not transfer adhesive, and instead dispense tape with adhesive permanently adhered to it. The Examiner has not provided any rationale as to why one skilled in the art would modify such a device to be used as an adhesive transfer device.

Accordingly, the Applicant submits that claim 1 is patentable over the art of record and that the obviousness rejection asserted by the Examiner should be withdrawn.

Claims 2-16 and 53-56 depend from claim 1 and are submitted to be patentable based on that dependency and also for the additional reason that they each recite additionally patentable features.

For example, claims 8 and 56 each recite that the combined density of the adhesive layers is greater than 25 grams per square meter. This is in addition to the features recited in intervening dependent claims of the adhesive layers being banded directly together with a weight ratio of repositionable adhesive to permanent adhesive being greater than 1:1. This specific combination is submitted to separately patentable and particularly advantageous.

Specifically, when layering the adhesive together, it is desirable to keep the ratio of repositionable adhesive to permanent adhesive above 1:1 to prevent the permanent adhesive from "overtaking" the repositionable adhesive. That is, if the permanent adhesive mixes too much with the repositionable adhesive, the permanent adhesive may undesirably increase the bonding characteristics of the repositionable adhesive. However, merely lowering the amount of permanent adhesive is undesirable in the context of the claimed invention. The ratio of 2:1, as set forth in claims 57 and 62, is even further beneficial for this reason.

The claimed invention is designed to allow the user to make an adhesive substrate out of a wide variety of substrate. Thus, to enable the adhesive layers to adhere to a wide variety of substrate, it is beneficial to use more permanent adhesive to enhance its tackiness and

sticking ability. Of course, merely increasing the amount of permanent adhesive would disrupt the ratio discussed above between the repositionable and permanent adhesives.

The invention of claims 8 and 56, and also claims 57 and 62, are beneficial for striking the appropriate balance between maintaining the proper ratio between the adhesives, and providing sufficient permanent adhesive for sending to a wide range of substrates.

Sasaki does not have any concern with adhering its permanent adhesive layer to a wide variety of substrates because it is a pre-made label. Its permanent adhesive is already bonded to a label substrate. Moreover, Sasaki does not teach a combined density of its adhesives that is greater than 25 grams per square meter. Thus, these dependent claims are submitted to be separately patentable.

#### Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance, and a Notice to that effect is earnestly solicited.

If the Examiner has any questions or suggestions for facilitating prosecution, he is urged to contact the undersigned at the below-listed telephone number.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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